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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,455	11/08/1999	CHRISTOPHER JAMES DANEK	435712000921	6666
41728	7590	12/29/2005	EXAMINER	
ASTHMATX, INC. 1340 SPACE PARK WAY MOUNTAIN VIEW, CA 94043			SHAY, DAVID M	
			ART UNIT	PAPER NUMBER
			3735	

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/436,455

Applicant(s)

DANEK ET AL.

Examiner

david shay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on October 11, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13, 18-75, 79-94 and 96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 18-75, 79-94 and 96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's arguments have been fully considered, but are not convincing. Regarding the base combination, applicant has overlooked several important points. Firstly, regarding Farley et al ('899), applicant argues that employing the actuator of Jackson et al in the device of Farley et al ('899) "significantly goes against the purpose of the Farley device". However, applicant has ignored both the fact that the actuator of Jackson et al could maintain the desired diameter of the device of Farley et al ('899), just as the configuration of Farley et al ('899), while, as *specifically stated* in the previous office action, allowing the diameter of the device to be decreased. It is further noted that the examiner's specifically stated motivation can be found within Farley et al ('899), at column 3: "re<sup>e</sup>ducing the number of wires can greatly reduce this concern" (see lines 19-20) and "those skilled in the art have recognized the needs for an expandable electrode catheter that has increased electrode size while maintaining the catheter size as small as practical". Thus applicant's arguments in this respect are not convincing.

With regard to Jackson et al, applicant argues that Jackson discloses the passage of the steering wire along with the signal wires, sighting column 12, lines 6-17. This argument fails for two reasons: firstly, in claim 59, for example, Jackson et al recite a device including "at least one wire having one end connected to the flexing element...ohmically heating body tissue by transmitting radio frequency energy through the electrode region..." such a method wherein the device includes exactly one wire, would require the bending wire to also be the current conducting wire; secondly, the passage cited by applicant also includes the following "Further details of this and other types of steering mechanisms are shown in Lundquist and Thompson

U.S. Pat. 5,254,088, which is incorporated into this Specification by reference.” The referenced disclosure, bolstering the examiner’s interpretation of e.g. claim 59, states, in the paragraph bridging columns 13-14: “the steering wire is attached to the extreme distal end of a lead spring 1640 carried within a steering shaft 1650...The lead spring 1640 is held in place relative to the steering shaft 1650 by means of an adhesive 1670. The adhesive 1670 may include an electrically conductive material, if the steering shaft is to be utilized in an embodiment wherein an electrode is desired at the tip of the steering shaft.”, which would clearly require the steering wire to be conductive, since the lead spring does not extend back to the proximal end of the device.

Claims 1-13, 18-52, 54-75, 79-94, and 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farley et al (‘899) in combination with Burnside et al and Jackson et al. Farley et al (‘899) teach a device claimed (see figures 2, 3, 6, 6a, and 8-11 and column 6, line 13 to column 19, line 6). The temperature sensor in the middle of leg 26 is considered inside some portions of the solder contacting each lead to the other and the electrode are considered separate attachments, and the voids allowing the legs to reach from the ring to the open space, are lumens), as well as the equivalence of conductive electrode on insulative legs and conductive electrodes on conductive legs. Burnside et al teach an energy transfer device which can have the claimed basket length (see column 40, lines 34-66); various numbers of legs (see Figure 7-9, 39A, 39 B, 40A and 55); various temperature sensor locations (see column 17 lines 5-30); wherein the attaching of Burnside et al is equivalent to soldering, welding, or adhesive bonding; has a polymeric heating element (see column 38, line 34-41); attaching by means of heat shrink tubing (see, e.g. column 20, lines 48-62); a with each basket leg in a lumen (see Figures 40A and

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40B); wherein the wall is reinforced by a metallic member ( see Figure 71B); and a wire carrying current ( see Figure 55). Jackson et al teach the use of a wire actuator, which alters the shape of the working element and also conducts energy to the working element. It would have been obvious to the artisan of ordinary skill to employ the leg, electrode and attaching structure of Burnside et al in the device of Farley et al since these are equivalents in the art, as shown by Burnside et al, and to employ heat shrink tubing as an attachment means for the electrode, since this is a recognized attachment means as also taught by Burnside et al or to employ the conductive legs, since these are equivalent to non-conductive legs as taught by Farley et al and to employ sterilization, the visualization system; locating the temperature detector between the leg and the resistively heated element; the use of D.C.current; forming the legs from a single sheet of stainless steel; to stop delivering energy if a temperature change is not detected and including an optical fiber and CCD, since these provide no unexpected result; and since they are not critical, and in either case to employ the wire configuration taught by Jackson et al, since this would impart a dual function to the actuating member, thereby reducing the complexity and girth of the device, thus producing a device such as claimed.

Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farley et al ('899) in combination with Burnside et al and Jackson et al as applied to claim 1-13, 18-52, 54-75, and 78-94 above, and further in combination with Fischell et al. Fischell et al teach the use of a sheath to actuate a multiple spline-positioning device in a surgical device. It would have been obvious to the artisan of ordinary skill to employ the sheath configuration of Fischell et al, since this would facilitate insertion of the device and to include the control mechanism claimed – a control member attached to the handle, since this is notorious means for actuating devices on

the distal portion of a bodily inserted device, official notice of which is hereby taken, thus producing a device such as claimed.

The examiner apologizes for the erroneous indication that claims 31-34 as allowable. The teaching of Burnside et al regarding heat shrink tubing were missed when the examiner was first reviewing the references.

Applicant's arguments filed October 11, 2005 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

Applicant's arguments with respect to claim 96 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ali Imam, can be reached on Monday, Tuesday, Wednesday, and Thursday at (571) 272-4740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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